

REMARKS**Summary of the Office Action**

In the Office Action, claims 16-19 stand rejected under 35 U.S.C. §101 as being directed to nonstatutory subject matter.

Claims 1-20 [sic] stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0198878 to *Baxter et al.* ("Baxter") in view of U.S. Patent No. 6,671,692 to *Marpe et al.*, hereinafter ("Marpe").

Summary of the Response to the Office Action

Applicants propose amending claims 16-19. Accordingly, claims 1-21 are pending for further consideration.

All Subject Matter Complies With 35 U.S.C. § 101

Informalities in claims 16-19 have been corrected as suggested by the Examiner. The rejection of these claims under 35 U.S.C. §101 as being directed to nonstatutory subject matter is respectfully traversed. Applicants respectfully submit that these claims, as amended, are in condition for allowance.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claims 1-20 [sic] stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Baxter* in view of *Marpe*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that independent claim 1 includes the features of "a system for quickly retrieving information that is related to a specific topic, the system comprises . . . the on-line reference tool links related units of information to glossary terms and writes at

least one question that corresponds to each link, wherein when a user selects a question, at least one unit of information is presented to the user.” At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Baxter* or *Marpe*.

Baxter discloses a system for organizing content from a variety of sources to be presented in a unified manner, such as on a web page. The system enables content creators, such as graphic artists, copyrighters, programmers, and editors, to create content for the web using tools with which they are familiar and without having to worry about integration of their content into web pages. See Abstract and page 1, paragraph 0005 of *Baxter*.

Marpe discloses a method for facilitating the navigation of applicant specific data on a web page, during use of a data browser. The data may be retrieved upon selection of the corresponding link, and the links are displayed, each as a component of indicia such as a pointer or chevron, to imply a relationship between the data. See Abstract of *Marpe*.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicants are under “no obligation to submit evidence of nonobviousness,” such as unexpected results or commercial success. *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any evidence of nonobviousness by the Applicants.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to

combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. None of the cited references teach or suggest at least “the online reference tool links related units of information to glossary terms and writes at least one question that corresponds to each link, wherein when a user selects a question, at least one unit of information is presented to the user,” as recited in independent claim 1.

As such, the suggestion or motivation to combine is not provided by either the references themselves or by knowledge generally available to one of ordinary skill in the art. Therefore, it is respectfully submitted that the statement in the Office Action is not sufficient by itself to meet the first prong of *prima facie* obviousness. In fact, the MPEP § 2143.01 states that “the level of skill in the art cannot be relied upon to provide the suggestion to combine references.” *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Second, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” See MPEP § 2143.01. The Office Action does not provide any citation to the references of record that shows the desirability of combining *Baxter* and *Marpe*. The mere assertion that *Baxter* and *Marpe* could be combined is not sufficient by itself to establish *prima facie* obviousness. Therefore, it is respectfully submitted that the Office Action has not met the second prong of *prima facie* obviousness.

Third, the Office Action has not established a *prima facie* case of obviousness at least because neither *Baxter* nor *Marpe*, whether alone or in combination, teach or suggest all the recited features of independent claim 1. Namely, neither *Baxter* nor *Marpe* teach or suggest at least “a system for quickly retrieving information that is related to a specific topic, the system comprises . . . the on-line reference tool links related units of information to glossary terms and writes at least one question that corresponds to each link, wherein when a user selects a question, at least one unit of information is presented to the user,” features recited in claim 1.

The Office Action simply states these features are present in *Baxter* without citing any supporting information from the reference itself. Claim language is simply recited as if the features exist in *Baxter*. Applicants find it difficult to respond because these features are not specifically identified. Therefore, Applicants respectfully request that if the present rejections are maintained, that the Office Action explicitly point out where in the cited references the above features are taught.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Baxter* and *Marpe* do not teach or suggest each and every feature of independent claim 1.

Additionally, Applicants respectfully submit that dependent claims 2-9 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

With respect to independent claim 10, Applicants respectfully submit that independent claim 10 includes the features of “at least one subject matter expert editor that filters each linked glossary term and writes a question that corresponds to the linked glossary term, wherein when the user selects the question the system presents at least one page that is associated with the linked glossary term.” At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Baxter* or *Marpe*.

The Office Action simply states these features are present in *Baxter* without citing any supporting information from the reference itself. For example, the Office Action states that the “subject matter expert editor that filters each linked term and writes a question that corresponds to the linked glossary term, wherein when the user selects the question the system presents at least one page is associated with the linked glossary term.” Claim-like language is loosely stated to imply that the features exist in *Baxter*. Applicants have difficulty responding because the stated features are not specifically identified and thus cannot be effectively refuted. In fact, the few references to *Baxter* or *Marpe* that are cited in the Office Action do not teach or suggest the features the Office Action states they teach.

For example, with respect to independent claim 11, Applicants respectfully submit that independent claim 11 includes the features of a “means for searching a content for the term and producing a list of terms, at least one definition for each term, and at least one question for each term that is linked to a teaching object.” At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Baxter* or *Marpe*.

The Office Action simply states these features are present in *Marpe* with little supporting information from the reference itself. For example, the Office Action states that the “at least one

definition for each term, and at least one question for each term that is linked to a teaching object (column 1, lines 35-60).” Reviewing lines 35-60 in *Marpe*, there is no teaching of a definition or a question linked to a teaching object. Thus, the Office Action incorrectly states these features are taught in *Marpe*. Therefore, Applicants respectfully request that if the present rejections are maintained, that the Office Action explicitly point out where in the cited references the above features are taught.

With respect to independent claim 16, Applicants respectfully submit that independent claim 16 includes the features of “using the teaching object identifier to produce a hyper-referencing table that links every glossary term to an appropriate page; filtering each reference in the hyper-referencing table and writing a corresponding question for the reference; and storing a modified hyper-referencing table that includes at least one corresponding question, wherein when the user selects a question that is related to a specific term, the appropriate page is presented to the user.” At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Baxter* or *Marpe*.

The Office Action simply states these features are present in *Marpe* with little supporting information from the reference itself. For example, the Office Action does not even mention the last three steps of using, filtering, and storing as recited above in claim 16. *Marpe* does not teach or suggest these features at all. Thus, the Office Action incorrectly states these features are taught in *Marpe*. Therefore, Applicants respectfully request that if the present rejections are maintained, that the Office Action explicitly point out where in the cited references the above features are taught.

With respect to independent claims 18 and 20, Applicants respectfully submit that independent claims 18 and 20 include the features of “using the teaching object identifier to produce a hyper-referencing table that links every glossary term to an appropriate page; filtering each reference in the hyper-referencing table and writing a corresponding question for the reference; storing a modified hyper-referencing table that includes at least one corresponding question.” At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Baxter* or *Marpe*.

The Office Action simply states these features are present in *Marpe* with little supporting information from the reference itself. For example, the Office Action does not even mention the 4th through 6th from the last step of using, filtering, and storing as recited above in claims 18 and 20. *Marpe* does not teach or suggest these features at all. The citation to col. 1, lines 35-60 of *Marpe* does not teach or suggest the claimed features. Thus, the Office Action incorrectly states these features are taught in *Marpe*. Therefore, Applicants respectfully request that if the present rejections are maintained, that the Office Action explicitly point out where in the cited references the above features are taught.

With respect to independent claim 21, Applicants respectfully submit that independent claim 21 includes the features of a “means for filtering each linked glossary term and writing a question that corresponds to the linked glossary term, wherein when the user selects the question the system presents at least one page that is associated with the linked glossary term.” At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Baxter* or *Marpe*.

The Office Action simply states these features are present in *Baxter* and *Marpe* with little supporting information from the reference itself. Claim language is simply recited as if the features exist in *Baxter* and *Marpe*. However, the Office Action fails to even mention the above-mentioned features of claim 21. Therefore, Applicants respectfully request that if the present rejections are maintained, that the Office Action explicitly point out where in the cited references the above features are taught.

Accordingly, Applicants respectfully submit that dependent claims 2-9, 12-15, 17, and 19 are also allowable insofar as they recite the patentable combinations of features recited in independent claims 1, 10, 11, 16, 18, 20, and 21, as well as reciting additional features that further distinguish over the applied prior art.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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